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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,261	12/03/2003	Herbert W. Harris	18184-0004 US	7783

23973 7590 11/30/2006

DRINKER BIDDLE & REATH
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EXAMINER	
CARTER, KENDRA D	
ART UNIT	PAPER NUMBER
1617	

DATE MAILED: 11/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
10/728261	12/3/03	Harris	18184-0004 US

EXAMINER	
Sreeni Padmanabhan	
ART UNIT	**PAPER NUMBER**

DATE MAILED:

INTERVIEW SUMMARY

All participants (applicant, applicant's representative, PTO personnel):

(1) Sreeni Padmanabhan (3) _____

(2) Daniel Monaco (4) _____

Date of Interview 8/30/06

Type: ☒ Telephonic ☐ Televideo Conference ☐ Personal (copy is given to ☐ applicant ☐ applicant's representative).

Exhibit shown or demonstration conducted: ☐ Yes ☐ No If yes, brief description: _____

Agreement ☒ was reached. ☐ was not reached.

Claim(s) discussed: _____

Identification of prior art discussed: _____

Description of the general nature of what was agreed to if an agreement was reached, or any other comments: _____

SSP for response to non-final action changed from 1 month to 3 months

(A fuller description, if necessary, and a copy of the amendments, if available, which the examiner agreed would render the claims allowable must be attached. Also, where no copy of the amendments which would render the claims allowable is available, a summary thereof must be attached.)

☐ It is not necessary for applicant to provide a separate record of the substance of the interview.

Unless the paragraph above has been checked to indicate to the contrary. A FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION IS NOT WAIVED AND MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has are ready been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW.

Examiner Note: You must sign this form unless it is an attachment to another form.

Padmanabhan

FORM **PTOL-413** (REV. 2-98)

Manual of Patent Examining Procedure, Section 713.04 Substance of Interview must Be Made of Record

Except as otherwise provided, a complete written statement as to the substance of any face-to-face or telephone interview with regard to an application must be made of record in the application, whether or not an agreement with the examiner was reached at the interview.

§1.133 Interviews

* * * * *

(b) In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111 and 1.135. (35 U.S.C. 132)

§ 1.2. Business to be transacted in writing. All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete a two-sheet carbon interleaf Interview Summary Form for each interview held after January 1, 1978 where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks in neat handwritten form using a ball point pen. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, pointing out typographical errors or unreadable script in Office actions or the like, or resulting in an examiner's amendment that fully sets forth the agreement are excluded from the interview recordation procedures below.

The Interview Summary Form shall be given an appropriate paper number, placed in the right hand portion of the file, and listed on the "Contents" list on the file wrapper. In a personal interview, the duplicate copy of the Form is removed and given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephonic interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication.

The Form provides for recordation of the following information:

- Application Number of the application
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (personal or telephonic)
- Name of participant(s)) (applicant, attorney or agent, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the claims discussed
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). (Agreements as to allowability are tentative and do not restrict further action by the examiner to the contrary.)
- The signature of the examiner who conducted the interview
- Names of other Patent and Trademark Office personnel present.

The Form also contains a statement reminding the applicant of his responsibility to record the substance of the interview.

It is desireable that the examiner orally remind the applicant of his obligation to record the substance of the interview in each case unless both applicant and examiner agree that the examiner will record same. Where the examiner agrees to record the substance of the interview, or when it is adequately recorded on the Form or in an attachment to the Form, the examiner should check a box at the bottom of the Form informing the applicant that he need not supplement the Form by submitting a separate record of the substance of the interview.

It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview:

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

1) A brief description of the nature of any exhibit shown or any demonstration conducted,
2) an identification of the claims discussed,
3) an identification of specific prior art discussed,
4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the examiner,
5) a brief identification of the general thrust of the principal arguments presented to the examiner. The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he feels were or might be persuasive to the examiner,
6) a general indication of any other pertinent matters discussed, and
7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete or accurate, the examiner will give the applicant one month from the date of the notifying letter to complete the reply and thereby avoid abandonment of the application (37 CFR 1.135(c)).

Examiner to Check for Accuracy

Applicant's summary of what took place at the interview should be carefully checked to determine the accuracy of any argument or statement attributed to the examiner during the interview. If there is an inaccuracy and it bears directly on the question of patentability, it should be pointed out in the next Office letter. If the claims are allowable for other reasons of record, the examiner should send a letter setting forth his or her version of the statement attributed to him. If the record is complete and accurate, the examiner should place the indication "Interview record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

Office Action Summary	Application No.	Applicant(s)	
	10/728,261	HARRIS ET AL.	
	Examiner	Art Unit	
	Kendra D. Carter	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) ~~OR THIRTY (30) DAYS~~, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 June 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-58* is/are pending in the application.

4a) Of the above claim(s) *13-58* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *12/3/2003*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

From the election restriction dated May 17, 2006, the Applicant elected in the remarks dated June 8, 2006 Group I (claims 1-12) without traverse on the right to obtain rejoinder of all other claims. Therefore, the restriction is upheld and made final.

Double Patenting Rejection

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent

and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1) Claims 1-12 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 7, and 9-12 of U.S. Patent No. US 6,638,928 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons below.

The U.S. Patent No. US 6,638,928 B1 discloses a method of treating or preventing irritable bowel syndrome or nonulcer dyspepsia comprising administering an effective amount of at least one compound according to formula I, which may be either (R) or (S), or a pharmaceutically acceptable salt thereof (see claim 1). The compound of formula I wherein R^1 and R^2 is $(C_1\text{-}C_7)$hydrocarbyl, R^3 and R^4 are $O(C_1\text{-}C_7)$hydrocarbyl, R^5 is OH, and R^6 is $O(C_1\text{-}C_7)$hydrocarbyl, corresponds to the applicant's

compound 1-(3,4-dimethoxyphenyl)-4-methyl-5-ethyl-7-methoxy-8-hydroxy-5H-2,3-benzodiazepine. In claim 12, US 6,638,928 B1 discloses a method comprising the applicant's specific compound stated above.

The U.S. Patent No. US 6,638,928 B1 does not disclose a composition of 1-(3,4-dimethoxyphenyl)-4-methyl-5-ethyl-7-methoxy-8-hydroxy-5H-2,3-benzodiazepine and in which the compound is in 85%, 90% or 95% by weight.

To one having ordinary skill in the art would find it obvious to formulate a composition of 1-(3,4-dimethoxyphenyl)-4-methyl-5-ethyl-7-methoxy-8-hydroxy-5H-2,3-benzodiazepine from the method of US 6,638,928 B1 because the method of treatment comprises administering the same compound, thus rendering the composition obvious. The weight percents of the composition would also be obvious because it is the normal desire of scientists or artisans to improve upon what is already generally known. In this case, US 6,638,928 B1 discloses that the compound of formula I be administered in a formulation between 0.1 to 99.91 weight percent (see column 17, lines 33-37). Thus, the composition of the (R) or (S)-enantiomer of 1-(3,4-dimethoxyphenyl)-4-methyl-5-ethyl-7-methoxy-8-hydroxy-5H-2,3-benzodiazepine in 85%, 90% or 95% by weight is taught by US 6,638,928 B1.

2) Claims 1-12 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 and 7-12 of U.S. Patent

No. US 6,864,251 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons below.

The U.S. Patent No. US 6,864,251 B2 discloses a method of treating an inflammatory disorder mediated by LTB_4 comprising administering an effective amount of at least one compound according to formula I in its (R)-enantiomer substantially free of the corresponding (S)-enantiomer, or a pharmaceutically acceptable salt thereof (see claim 1). The compound of formula I wherein R^1 and R^2 are $(C_1\text{-}C_7)$hydrocarbyl, R^3 and R^5 are $O(C_1\text{-}C_7)$hydrocarbyl, n = 2, and R^4 is OH, corresponds to the applicant's compound 1-(3,4-dimethoxyphenyl)-4-methyl-5-ethyl-7-methoxy-8-hydroxy-5H-2,3-benzodiazepine. In claim 5, US 6,864,251 B2 discloses a method comprising the applicant's specific compound stated above.

The U.S. Patent No. US 6,864,251 B2 does not disclose a composition of the (R) and (S)-enantiomer of 1-(3,4-dimethoxyphenyl)-4-methyl-5-ethyl-7-methoxy-8-hydroxy-5H-2,3-benzodiazepine and in which the compound is in 85%, 90% or 95% by weight.

To one having ordinary skill in the art would find it obvious to formulate a composition of the (R) and (S)-enantiomer of 1-(3,4-dimethoxyphenyl)-4-methyl-5-ethyl-7-methoxy-8-hydroxy-5H-2,3-benzodiazepine from the method of US 6,864,251 B2 because the method of treatment comprises administering the (R)-enantiomer of the same compound, thus rendering the composition obvious.

A composition of the racemic mixture or the (S)-enantiomer is obvious because the (R)-enantiomer is taught by US 6,864,251 B2. Stereoisomerism is well known to persons having ordinary skill in the art. A person having ordinary skill in the art would have been motivated to obtain the racemic mixture and the (S)-enantiomer with a reasonable expectation of achieving substantially different pharmacological activity.

The weight percents of the composition would also be obvious because it is the normal desire of scientists or artisans to improve upon what is already generally known. In this case, US 6,863,251 B2 discloses that the compound of formula I be administered in a formulation between 0.1 to 99.91 weight percent (see column 20, lines 59-64). Thus, the composition of the (R) and (S)-enantiomer of 1-(3,4-dimethoxyphenyl)-4-methyl-5-ethyl-7-methoxy-8-hydroxy-5H-2,3-benzodiazepine in 85%, 90% or 95% by weight is taught by US 6,863,251 B2.

3) Claims 1-12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18, 23 and 29 of copending Application No. 10/461290.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons below.

The U.S. Application 10/461290 discloses a method of modulating domamine resposes in the central nervous system comprising administering an effective amount of at least one compound according to formula I in its (S)-enantiomer substantially free of the corresponding (R)-enantiomer, or a pharmaceutically acceptable salt thereof (see claim 1). The compound of formula I wherein R^1 and R^2 are $(C_1\text{-}C_7)$hydrocarbyl, R^3 and R^4 are $O(C_1\text{-}C_7)$hydrocarbyl, R^5 is OH, and R^6 is $O(C_1\text{-}C_7)$hydrocarbyl, corresponds to the applicant's compound 1-(3,4-dimethoxyphenyl)-4-methyl-5-ethyl-7-methoxy-8-hydroxy-5H-2,3-benzodiazepine. In claim 33, 10/461290 discloses a method comprising the applicant's specific compound stated above.

10/461290 does not disclose a composition of the (R) and (S)-enantiomer of 1-(3,4-dimethoxyphenyl)-4-methyl-5-ethyl-7-methoxy-8-hydroxy-5H-2,3-benzodiazepine and in which the compound is in 85%, 90% or 95% by weight.

To one having ordinary skill in the art would find it obvious to formulate a composition of the (R) and (S)-enantiomer of 1-(3,4-dimethoxyphenyl)-4-methyl-5-ethyl-7-methoxy-8-hydroxy-5H-2,3-benzodiazepine from the method of 10/461290 because the method of treatment comprises administering the (S)-enantiomer of the same compound, thus rendering the composition obvious.

A composition of the racemic mixture or the (R)-enantiomer is obvious because the (S)-enantiomer is taught by 10/461,290. Stereoisomerism is well known to persons having ordinary skill in the art. A person having ordinary skill in the art would have been motivated to obtain the racemic mixture and the (R)-enantiomer with a reasonable expectation of achieving substantially different pharmacological activity.

The weight percents of the composition would also be obvious because it is the normal desire of scientists or artisans to improve upon what is already generally known. Thus, the composition of the (R) and (S)-enantiomer of 1-(3,4-dimethoxyphenyl)-4-methyl-5-ethyl-7-methoxy-8-hydroxy-5H-2,3-benzodiazepine in 85%, 90% or 95% by weight is taught by10/461290.

4) Claims 1-12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7, 9-13, 15, and 25-31 of copending Application No. 10/727,940.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.
Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons below.

The U.S. Application 10/727,940 discloses a method of treating an individual afflicted with an inflammatory disorder comprising administering an effective amount of at least one compound according to formula I in a racemic mixture of (R)- and (S)- (see claim 1) or the (R)-enantiomer substantially free of the corresponding (S)-enantiomer, or a pharmaceutically acceptable salt thereof (see claim 9). The compound of formula I wherein R^1 and R^2 are $(C_1\text{-}C_7)$hydrocarbyl, R^3 and R^5 are $O(C_1\text{-}C_7)$hydrocarbyl, n = 2, and R^4 is OH, corresponds to the applicant's compound 1-(3,4-dimethoxyphenyl)-4-methyl-5-ethyl-7-methoxy-8-hydroxy-5H-2,3-benzodiazepine. In claim 7, 10/727,940 discloses a method comprising the applicant's specific compound stated above.

10/727,940 does not disclose a composition of the (R)- and (S)-enantiomer of 1-(3,4-dimethoxyphenyl)-4-methyl-5-ethyl-7-methoxy-8-hydroxy-5H-2,3-benzodiazepine and in which the compound is in 85%, 90% or 95% by weight.

To one having ordinary skill in the art would find it obvious to formulate a composition of the (R) or (S)-enantiomer of 1-(3,4-dimethoxyphenyl)-4-methyl-5-ethyl-7-methoxy-8-hydroxy-5H-2,3-benzodiazepine from the method of 10/727,940 because the method of treatment comprises administering the racemic mixture and the (R)-enantiomer of the same compound, thus rendering the composition obvious.

A composition of the (S)-enantiomer is obvious because the racemic mixture and the (R)-enantiomer is taught by 10/727,940. Stereoisomerism is well known to persons

having ordinary skill in the art. A person having ordinary skill in the art would have been motivated to resolve the racemic mixture with the reasonable expectation of achieving substantially different pharmacological activity.

The weight percents of the composition would also be obvious because it is the normal desire of scientists or artisans to improve upon what is already generally known. Thus, the composition of the (R) and (S)-enantiomer of 1-(3,4-dimethoxyphenyl)-4-methyl-5-ethyl-7-methoxy-8-hydroxy-5H-2,3-benzodiazepine in 85%, 90% or 95% by weight is taught by 10/727,940.

5) Claims 1-12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6, 8-12, 14-16, 23-25, 34 and 36 of copending Application No. 10/728,286.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.
Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons below.

The U.S. Application 10/728,286 discloses a method of increasing the absolute neutrophil count in an individual comprising administering an effective amount of at least one compound according to formula I in a racemic mixture of (R)- and (S)- (see claim 1)

or the (R)-enantiomer substantially free of the corresponding (S)-enantiomer, or a pharmaceutically acceptable salt thereof (see claim 8). The compound of formula I wherein R^1 and R^2 are $(C_1\text{-}C_7)$hydrocarbyl, R^3 and R^5 are $O(C_1\text{-}C_7)$hydrocarbyl, n = 2, and R^4 is OH, corresponds to the applicant's compound 1-(3,4-dimethoxyphenyl)-4-methyl-5-ethyl-7-methoxy-8-hydroxy-5H-2,3-benzodiazepine. In claim 6, 10/728,286 discloses a method comprising the applicant's specific compound stated above.

10/728,286 does not disclose a composition of the (R)- and (S)-enantiomer of 1-(3,4-dimethoxyphenyl)-4-methyl-5-ethyl-7-methoxy-8-hydroxy-5H-2,3-benzodiazepine and in which the compound is in 85%, 90% or 95% by weight.

To one having ordinary skill in the art would find it obvious to formulate a composition of the (R) or (S)-enantiomer of 1-(3,4-dimethoxyphenyl)-4-methyl-5-ethyl-7-methoxy-8-hydroxy-5H-2,3-benzodiazepine from the method of 10/728,286 because the method of treatment comprises administering the racemic mixture and the (R)-enantiomer of the same compound, thus rendering the composition obvious.

A composition of the (S)-enantiomer is obvious because the racemic mixture and the (R)-enantiomer is taught by 10/728,286. Stereoisomerism is well known to persons having ordinary skill in the art. A person having ordinary skill in the art would have been motivated to resolve the racemic mixture with the reasonable expectation of achieving substantially different pharmacological activity.

The weight percents of the composition would also be obvious because it is the normal desire of scientists or artisans to improve upon what is already generally known. Thus, the composition of the (R) and (S)-enantiomer of 1-(3,4-dimethoxyphenyl)-4-methyl-5-ethyl-7-methoxy-8-hydroxy-5H-2,3-benzodiazepine in 85%, 90% or 95% by weight is taught by 10/728,286.

6) Claims 1-12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 9-21, and 30-31 of copending Application No. 10/827,839.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.
Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons below.

The U.S. Application 10/827,839 discloses a method of lowering body temperature of an individual comprising administering an effective amount of at least one compound according to formula I in its (R)-enantiomer substantially free of the corresponding (S)-enantiomer, or a pharmaceutically acceptable salt thereof (see claim 8). The compound of formula I wherein R^1 and R^2 are (C_1-C_7)hydrocarbyl, R^{3b}, R^{3c} and R^5 are O(C_1-C_7)hydrocarbyl, R^{3a} is H, and R^4 is OH, corresponds to the applicant's compound 1-(3,4-

dimethoxyphenyl)-4-methyl-5-ethyl-7-methoxy-8-hydroxy-5H-2,3-benzodiazepine. In claim 6, 10/827,839 discloses a method comprising the applicant's specific compound stated above.

10/827,839 does not disclose a composition of the (R)- and (S)-enantiomer of 1-(3,4-dimethoxyphenyl)-4-methyl-5-ethyl-7-methoxy-8-hydroxy-5H-2,3-benzodiazepine and in which the compound is in 85%, 90% or 95% by weight.

To one having ordinary skill in the art would find it obvious to formulate a composition of the (R) or (S)-enantiomer of 1-(3,4-dimethoxyphenyl)-4-methyl-5-ethyl-7-methoxy-8-hydroxy-5H-2,3-benzodiazepine from the method of 10/827,839 because the method of treatment comprises administering the (R)-enantiomer substantially free of the corresponding (S)-enantiomer of the same compound, thus rendering the composition obvious.

A composition of the racemic mixture or the (S)-enantiomer is obvious because the (R)-enantiomer is taught by 10/827,839. Stereoisomerism is well known to persons having ordinary skill in the art. A person having ordinary skill in the art would have been motivated to obtain the (S)-enantiomer or the racemic mixture with the reasonable expectation of achieving substantially different pharmacological activity.

The weight percents of the composition would also be obvious because it is the normal desire of scientists or artisans to improve upon what is already generally known. Thus, the composition of the (R) and (S)-enantiomer of 1-(3,4-dimethoxyphenyl)-4-methyl-5-ethyl-7-methoxy-8-hydroxy-5H-2,3-benzodiazepine in 85%, 90% or 95% by weight is taught by 10/827,839.

7) Claims 1-12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 9-22, and 31 of copending Application No. 10/781,422.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.
Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons below.

The U.S. Application 10/781,422 discloses a method of lowering body temperature of an individual comprising administering an effective amount of at least one compound according to formula I in its (S)-enantiomer substantially free of the corresponding (R)-enantiomer, or a pharmaceutically acceptable salt thereof (see claim 8). The compound of formula I wherein R^1 and R^2 are $(C_1$-$C_7)$hydrocarbyl, R^{3b}, R^{3c} and R^5 are $O(C_1$-$C_7)$hydrocarbyl, R^{3a} is H, and R^4 is OH, corresponds to the applicant's compound 1-(3,4-dimethoxyphenyl)-4-methyl-5-ethyl-7-methoxy-8-hydroxy-5H-2,3-benzodiazepine. In

claim 6, 10/781,422 discloses a method comprising the applicant's specific compound stated above.

10/781,422 does not disclose a composition of the (R)- and (S)-enantiomer of 1-(3,4-dimethoxyphenyl)-4-methyl-5-ethyl-7-methoxy-8-hydroxy-5H-2,3-benzodiazepine and in which the compound is in 85%, 90% or 95% by weight.

To one having ordinary skill in the art would find it obvious to formulate a composition of the (R) or (S)-enantiomer of 1-(3,4-dimethoxyphenyl)-4-methyl-5-ethyl-7-methoxy-8-hydroxy-5H-2,3-benzodiazepine from the method of 10/827,839 because the method of treatment comprises administering the (S)-enantiomer substantially free of the corresponding (R)-enantiomer of the same compound, thus rendering the composition obvious.

A composition of the racemic mixture or the (R)-enantiomer is obvious because the (S)-enantiomer of formula I is taught by 10/781,422. Stereoisomerism is well known to persons having ordinary skill in the art. A person having ordinary skill in the art would have been motivated to obtain the (R)-enantiomer or the racemic mixture with the reasonable expectation of achieving substantially different pharmacological activity.

The weight percents of the composition would also be obvious because it is the normal desire of scientists or artisans to improve upon what is already generally known.

Thus, the composition of the (R) and (S)-enantiomer of 1-(3,4-dimethoxyphenyl)-4-methyl-5-ethyl-7-methoxy-8-hydroxy-5H-2,3-benzodiazepine in 85%, 90% or 95% by weight is taught by10/781,422.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kendra D. Carter whose telephone number is (571) 272-9034. The examiner can normally be reached on 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KDC

SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER